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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,538	09/13/2001	Seiichi Tagawa	6404-03WOUS	7147

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EXAMINER	
RHEE, JANE J	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 11/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

C108

Office Action Summary	Application No.	Applicant(s)	
	09/936,538	TAGAWA ET AL.	
	Examiner	Art Unit	
	Jane J Rhee	1772	

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Hamackers (5966996).

Watanabe et al. discloses a damper comprising a hub (figure 1 number 21), an inertia mass body (figure 1 number 3) and a polymer elastic body (figure 1 number 22) such as rubber press-fitted between the hub and the inertia mass body from an axis direction thereof (figure 1 numbers 21,22, 3), wherein the polymer elastic body is a vulcanized and molded rubber elastic body (line 16 lower right column, page 2 to line 11 upper right column of english translation), and an organosilane as a nonslip agent is provided at least one of between the hub formed by a metal member and the polymer elastic body and between the inertia mass body formed by a metal member and the polymer elastic body (abstract lines 5-7).

Watanabe et al. fail to disclose that the surface roughness in at least one of a metal surface adhering to the polymer elastic body in the hub and a metal surface adhering to the polymer elastic body in the inertia mass body is within a range of 5-50μm. Even though Hamackers fails to teach the claim surface roughness of 5-50μm, Hamackers

clearly suggests a suitable surface roughness that would be determined depending on the mutually facing surface of the machine element (col. 2, lines 60-64). Hamackers further teaches that the coarse surface roughness in particular is suitable when the machine element and extension piece are adhesively bonded to one another for he purpose of ensuring a good durable bond between the adhesive and the adjacent components (col. 2 lines 65-col. 3 lines 1-3).

Therefore, one of ordinary skill in the art would have recognized the optimum surface roughness such as claimed 5-50um would be readily determined through routine experimentation depending on the suitability. Thus, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have modified Watanabe's surface roughness in the metal surface adhering to the polymer elastic body since the surface roughness would be determined depended on the mutually face surface e of machine element as described by Hamackers.

Process limitations are given little or no patentable weight. Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation that the inertia mass is without performing chemical surface treatment is a method of production and therefore does not determine the patentability of the product itself.

Response to Arguments

2. Applicant's arguments filed 8/15/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Watanabe refers to numeral 21 as the "mass body" not a hub and numeral 3 as the "ring plate" not an inertia mass body, the Examiner took the position to call the "mass body" the hub and the "ring plate" an inertia mass body since the term "hub" and "inertia mass body" was examined at its broadest definition.

In response to applicant's argument that Watanabe does not disclose or show that the polymer elastic body is press-fitted between the hub and the inertial mass, the limitation press fitted is a process limitation which are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the

claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case press-fitted a method of production and therefore does not determine the patentability of the product itself.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jane Rhee
November 3, 2003

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/3/03